UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte MONTY KRIEGER

Appeal 2006-3255
Application 09/148,012
Technology Center 1600

ON BRIEF

Before SCHEINER, ADAMS, and GRIMES, *Administrative Patent Judges.*

GRIMES, *Administrative Patent Judge.*

REMAND TO THE EXAMINER

This application is before the Board for the second time. In the previous appeal, the panel vacated the rejections on appeal and entered a new ground of rejection on the basis that the claims had been amended to the point that they were directed to prohibited new matter. (Decision mailed March 29, 2005.)

In response to the new ground of rejection, Appellant amended the claims. (Amendment received May 31, 2005.) The Examiner indicated that the amendment overcame the new matter rejection, and entered final

rejections of the claims for lack of enablement and lack of adequate written description. (Office action mailed August 15, 2005.) Appellant filed a new Notice of Appeal and Appeal Brief, and the Examiner filed a new Examiner's Answer and returned the case to our jurisdiction.

The following issue must be addressed before we can reach the merits of the rejections:

The rejections set out in the Examiner's Answer are not the same as the rejections made in the Final Office action (mailed August 15, 2005) and do not address the limitations of the claims as they currently stand.

In the amendment filed May 31, 2005, sole independent claim 1 was amended as follows:

1. (currently amended) A method for ~~altering fertility or treating a reproductive disorder in a female~~ inhibiting pregnancy or decreasing production of steroids in a mammal ~~in need of treatment thereof~~ comprising

administering a compound ~~altering lipoprotein, LDL, HDL or cholesterol levels~~ inhibiting uptake, binding or transport of cholesteryl ester by SR-BI in the mammal in an amount effective to ~~enhance or restore fertility or treat a reproductive disorder in the mammal~~ to inhibit pregnancy or to decrease production of steroids in disorders involving steroidal overproduction.

The Examiner rejected the amended claims for lack of written description and lack of enablement, reasoning that the specification does not adequately describe compounds that block binding to SR-B1 and does not enable methods of improving fertility in animals other than mice with an SR-B1 knock-out mutation. (Office action mailed August 15, 2005, pages 3 and 4.)

In the Examiner's Answer mailed May 30, 2006, however, the claims are not rejected on these bases. Rather, the rejections in the Examiner's Answer appear to be addressed to the claims as they stood at the time of the first appeal to the Board; i.e., before they were amended in response to the new matter rejection. See the Examiner's Answer, page 3:

> Appellant has provided no written description of any compounds which alter *fertility* or treat reproductive disorders by altering lipoprotein, LDL, HDL, or cholesterol levels in the mammal.

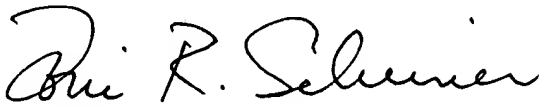
See also *id.* at 5:

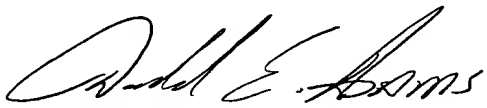
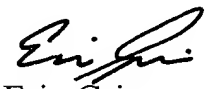
> [T]he specification, while being enabling for altering cholesterol levels in female mice by knocking out the SR-B1 gene, does not reasonably provide enablement for any method of altering fertility or treating *any and all* reproductive disorders by altering lipoprotein, LDL, HDL, or cholesterol levels in a mammal.

Because the rejections on appeal do not address the limitations of the claims, as amended, the Examiner's Answer does not make clear what issues are presented for decision. On return of this application, the Examiner should consider whether the Examiner's Answer mailed May 30, 2006, accurately reflects the bases for rejecting the claims. If the Examiner concludes that the rejections set out in the Examiner's Answer are not the intended rejections, the Examiner's Answer mailed May 30, 2006, should be vacated and a new Examiner's Answer should be issued that accurately states the rejections to be presented on appeal.

This application, by virtue of its "special" status, requires an immediate action. MPEP § 708.01. It is important that the Board be informed promptly of any action affecting the appeal in this case.

REMANDED



Toni R. Scheiner)
Administrative Patent Judge)
)
)

) BOARD OF PATENT
Donald E. Adams)
Administrative Patent Judge) APPEALS AND
)

) INTERFERENCES
)
Eric Grimes)
Administrative Patent Judge)

EG/jlb

Patrea L. Pabst
Pabst Patent Group LLP
400 Colony Square
Suite 1200
Atlanta, GA 30361